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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/723,362	11/27/00	CHAINER	T YOR919940252

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WM02/0423

EXAMINER

SNIEZEK, A

ART UNIT

PAPER NUMBER

2651

DATE MAILED:

04/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/723,362

Applicant(s)

Chainer et al.

Examiner
ANDREW L. SNIEZEK

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2651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 27, 2000
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-28 and 53-71 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-28 and 53-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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1. The following action is taken in view of the amendment filed 11/27/00.
2. The drawings as filed appear to be formal however are waiting approval from the draftsman.
3. The information disclosure statement filed 11/27/00 has been considered.
4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 25-28 and 53-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 sets forth a method for correcting for systematic errors, however the body of the claims do not set forth any limitations defining the method. The limitations "detecting" and "correcting" only lets one know that there is an error and it is corrected, however the actual method of correcting is not defined. Claims 26-28 inherit this language. Claim 60, although uses the terms "taking" and "using" do not define the method for determining time delays for similar reasons. Claims 61-65 inherit the limitations of claim 60. Claim 53, although written as an apparatus claim does not set forth any specifics of the structure used for the correction of errors for similar reasons as discussed above with respect to claim 25. Furthermore, no definite meaning can be given to the word "adapted". Any apparatus can be adapted to perform a function. The structure that is used to perform the function must be claimed. Dependent claims 54-56 inherit

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the language of claim 53., Also, these dependent claims also contain the word "adapted" that for reasons already given is deemed indefinite. Claim 66 sets forth general terms which do not properly define the invention for reasons given above. Claims 67-71 inherit the language of claim 66. Claim 57 sets forth that "systematic errors are eliminated" however the arrangement of element(s) that enables this function is missing from the claim. The last phrase of claim 57 starting with "rotation of said servo-pattern ..." is confusing since it is not clear how the pattern is rotated, with respect to what is the pattern rotated. Furthermore, since the head moves in a radial direction, there would be no need to adjust the rotation of the pattern but instead have a fixed orientation since the radial movement is along a straight line. Claims 58-59 inherit this language. Claims 58-59 also use the term "adapted" which is indefinite for reasons already given.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 60-62 and 64 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3 of copending

Application No. 09/145,930. Claims 66-68 and 70 are provisionally rejected under the judicially

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created doctrine of obviousness-type double patenting as being unpatentable over claims 25, 27 of copending Application No. 09/145,930. Although the conflicting claims are not identical, they are not patentably distinct from each other because although written using different terminology each is directed to the determination of delay times, i.e. off-track time shifts by taking plural samples at radial locations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

9. Claims 25, 26, 53, 54, 57, 58, 60-64, 66-70 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al. (5,682,274).

Brown teaches a apparatus and method for correcting for track misregistration between a read head and a write head by detecting and correcting in a manner as set forth in claims 25-26, 53, 54. As seen from Brown et al. (figure 7) the heads are circumferentially space one from another with respect to specific track location on the disk and also spaced at different distances from the given track. These spacings relate to systematic errors, i.e. time delays, as claimed. The limitations of claims 57 and 58 as best as understood in view of the 35 U.S.C. 112 rejections is

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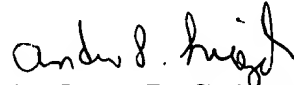
also satisfied by Brown et al. The limitations of claims 60-64 and 66-70 although using slightly different terminology are also deemed satisfied by Brown et al. as discussed.

10. Claims 27, 28, 55, 56, 59, 65 and 71 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Snizek whose telephone and VoiceMail number is (703) 308-1602. If a plurality of attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Hudspeth, can be reached on (703) 308-4825

The appropriate fax phone number for the organization (Group 2650) where this application or proceeding is assigned is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.


Andrew L. Snizek
Primary Examiner
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A.L.S.
April 20, 2001